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## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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In re Applicant:	Brad D. Rumsey	§	Art Unit:	2827
Serial No.:	09/377,286	§		
Filed:	August 18, 1999	§	Examiner:	K. Cuneo
Title:	Positioning Flowable Solder For Bonding Integrated Circuit Elements	§	Docket No.	MCT.0050US (99-0325)

Commissioner for Patents  
Washington DC 20231

**Petition to the Supervisory Patent Examiner Under MPEP § 1002.02(d) 2**  
**Reopening of Prosecution After Filing An Appeal Brief in Order**  
**To Incorporate a New Ground of Rejection**

The Examiner has asserted a new ground of rejection in the Examiner's Answer mailed on May 21, 2002. The applicant requests that prosecution be re-opened in view of the new ground of rejection.

**Facts Involved**

1. On March 14, 2001, claims 1-6, 9-12, 14, 16 and 19 were rejected under §102(b) and (e) as being anticipated by Healy et al. Three U.S. patents were cited as related prior art but were not relied on to make or support the rejection.
2. On July 6, 2001, the same rejection was made. Again, only Healy et al. was relied on to support the rejection.

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Debra Cutrona

3. On November 9, 2001, applicant submitted an Appeal Brief arguing against the §102 rejections in view of Healy et al.
4. On May 21, 2001, in the Examiner's Answer, for the first time the examiner expressly relied on the Abe (US Patent No. 6,028,366), Schuller (US Patent No. 5,585,162) and Natarajan et al. (US Patent No. 5,519,580) patents to support the §102 rejections.

**Exemplary Claims: Independent Claims 1 and 10**

1. A bond pad assembly comprising:
  - a bond pad;
  - a trace that applies an attractive force to solder placed on the pad, said trace coupled to said pad and extending away from said pad in a first direction; and
  - a trace stub to counteract the attractive force applied by the trace, said trace stub coupled to said pad and extending away from said pad in a direction other than said first direction.
10. A bonding system comprising:
  - a bond pad;
  - a trace coupled to said bond pad and extending away from said pad; and
  - an element adapted to counteract an attractive force applied by the trace to solder placed on the bond pad.

**Points to be Reviewed**

Until now, the examiner has relied on Healy et al. to support an anticipation rejection. Applicant has argued that Healy does not anticipate the claims. See Paper No. 6 and Paper No. 8. After final rejection, the applicant appealed to the Board of Patent

Appeals and Interferences regarding the claim rejections. For the first time, the examiner has asserted in his answer to the applicant's Appeal Brief, that

"one of ordinary skill in the art, would have construed the void illustrated by Healy as defining an exposed pad and exposed portions of the trace and stub as shown in figures 1 and 4. To support this assertion, examiner points to all of the other prior art of record...which have better illustrations and clearly show that where the insulation is receded around the pad, parts of the trace remain exposed. This is what figures 1 through 4 also show."

See Paper No. 12, page 5. It respectfully submitted that the examiner's newfound reliance on the Abe, Schuller and Natarajan patents creates a new ground of rejection.

#### **Requested Action**

In the Examiner's Answer a new ground of rejection is recited. Therefore, the final rejection should be withdrawn and prosecution reopened in view of the new ground rejection.

#### **Legal Argument**

The evidence newly cited by the examiner changes the thrust of the original rejection. When a reference is relied on to support a rejection, even if the reference is relied on in a minor capacity, the references should be positively included in the statement of the rejection. *See In re Hoch*, 166 U.S.P.Q. 406, 407 n.3 (CCPA 1970). Moreover, if the applicant is not given a fair opportunity to react to the thrust of the rejection, a new ground of rejection is asserted. *See in re Kronig*, 190 U.S.P.Q. 425, 426-427 (CCPA 1976).

It is debated whether the structure disclosed by Healy alone is the same as the structure that is claimed. To support his position that Healy anticipates the claims, the

examiner, for the first time in the Examiner's Answer, relies on the teachings of Abe, Schuller and Natarajan et al. as evidence of what one with ordinary skill in the art would have perceived Healy to be structurally.

The examiner's reliance on three new patents to positively support his rejection in of itself creates a new ground of rejection. Moreover, the reliance on the Abe, Schuller and Natarajan patents changes the thrust of the §102 rejections. For example, the issue has changed from does Healy alone teach every claimed element to does Healy, in view of Abe, Schuller and Natarajan teach every claimed element? Moreover, if this new ground of rejection is viewed as a §103(a) rejection, a further issue may include whether there is any suggestion or motivation to modify or combine the teachings of the relied upon references. Accordingly, the applicant has not had a fair opportunity to respond to the examiner's new assertions.

Even if it is perceived that the examiner is merely relying upon the additional references to show enablement of Healy, it is respectfully submitted that in view of the new evidence, the applicant has not been given a fair opportunity to respond to what the examiner implicitly asserts is already in the public's possession. Accordingly, the final rejection should be withdrawn so that the applicant may be given an opportunity to respond the examiner's newly asserted ground of rejection.

#### **Fee**

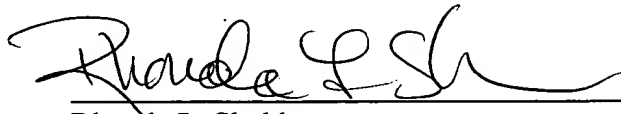
A petition brought pursuant to Rule 1.181 does not have a fee expressly provided for in Rule 1.17. The Commissioner is authorized to charge any additional fees to Deposit Account No. 20-1504 (MCT.0050US).

**Statement that Petition is Timely Filed**

The complained about action took place on May 21, 2002, thus this matter has been addressed within two months of that date.

Respectfully submitted,

Date: \_\_\_\_\_

June 10, 2002 

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